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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/943,799	08/31/2001	JiNan Glasgow		1070

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JiNan Glasgow
Spore, Inc.
P.O. Box 28539
Raleigh, NC 27611-8539

EXAMINER	
LY, ANH	

ART UNIT	PAPER NUMBER
2162	

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06/07/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/943,799	GLASGOW, JINAN	
	Examiner	Art Unit	
	Anh Ly	2162	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 June 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-19* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This Office Action is response to Applicant's AMENDMENT filed on 06/30/2006.

Request for Continued Examination (RCE)

2. The request filed on 06/30/2006 for a Request for Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 09/943,799 is acceptable and a RCE has been established. An action on the RCE follows.

3. Claims 1-19 are pending in this Application.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-6 and 11-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Pub. No.: US 2006/0190807 A1 of TRAN.

With respect to claim 1, TRAN teaches a system for drafting a patent application and assessing technological information on at least one computer (fig. 1, a system for user(s) such as IP specialist or attorney in drafting or writing patent applications or patent claims as well as technical information as legal matters for a patent application: sections 0006, 0010 and 0132-0133), the system comprising:

at least one input device connected to the at least one computer for inputting information from at least one user (inputting from one of client computers: fig. 1, items 104 and 106, sections 0035);

at least one processing means for generating a diagrammatic representation of an invention (using graphical user interface and software for assisting the user in generating a patent application: sections 0042-0043 and fig. 2A and 2C), wherein the diagrammatic representation includes a hierarchical component categorization of the technical components of the invention based upon the information inputted by the at least one user (fig. 3B a claim tree, sections 0068), and for automatically generating a document for filing as a patent application (automatically generating a patent application: fig. 2's section 0042), including specification and claims, based upon the information inputted by the at least one user and additional text-based detailed information that is organized consistent with the diagram (technical component such as background, description, drawings and claims: abstract, figs. 2C, 3A and 4-5, sections 0008, 0016, 0046 and 0101-0103); wherein the hierarchical component categorization includes at least one key component and at least one subcomponent related thereto, wherein the diagrammatic representation of the components and subcomponents together provides an indication of what may be claimed in a patent application (independent claims and dependent claims: in fig. 3B claim tree and sections 0053-0054); and

at least one output device connected to the at least one computer for outputting the automatically generated diagrammatic representation of an invention (the claim tree is displayed on the desktop screen, output device: section 0127 and fig. 3B).

With respect to claim 2, TRAN teaches wherein the diagram is modifiable by the at least one user and the diagram hierarchical component categorization and related text-based detailed information is automatically updated based upon the user modifications (the text of a patent application is enabling to update or edit: section 0044 and claim tree is also able to move or to modify (drag/drop claims): sections 0068).

With respect to claim 3, TRAN teaches wherein the at least one key component includes a multiplicity of components (such as one independent claim has one or more dependent claims as shown in the fig. 3B: claim tree: sections 0068 or a patent application has background, summary, description, drawings and claims components: sections 0008, 0016 and 0044-0045).

With respect to claim 4, TRAN teaches wherein the at least one subcomponent further includes at least one sub-subcomponent (independent and dependent claims: claim tree: sections 0068 and 0053-0054).

With respect to claim 5, TRAN teaches wherein the relational connection between components establishes the claims structure of the patent application (relationship between component in the data structure: section 0101 and fig. 4).

With respect to claim 6, TRAN teaches wherein the text-based information and the diagram components are automatically linked (the links of the text-based: description: section 0044).

Claim 11 is essentially the same as claim 1 except that it is directed to a method rather than a system, and is rejected for the same reason as applied to the claim 1 hereinabove.

With respect to claim 12, TRAN teaches further including the step of: at least one user entering diagram verbiage by drafting the text-based detailed description or verbiage of the specification section of the application for each component of the diagram (a process performed by the software for assisting the user in generating a patent application: figs. 2's and 3B).

With respect to claim 13, TRAN teaches further including the step of: at least one user inputting additional components selected from the group consisting of key components, subcomponents, and sub-subcomponents (a patent application has background, summary, description, drawings and claims components or such as one independent claim has one or more dependent claims as shown in the fig. 3B: claim tree: sections 0068; also see sections 0008 and 0016).

With respect to claim 14, TRAN teaches further including the steps of: modifying any previously inputted components within the diagram; and the system automatically updating the diagram and relational information to those modified components (the text of a patent application is enabling to update or edit: section 0044 and claim tree is also able to move or to modify (drag/drop claims): sections 0068).

With respect to claim 15, TRAN teaches further including the step of: automatically generating a patent application based upon the inputted information and the hierarchical diagram, including specification and claims (such as one independent

claim has one or more dependent claims as shown in the fig. 3B: claim tree: sections 0068 or a patent application has background, summary, description, drawings and claims components: sections 0008, 0016 and 0044-0045).

With respect to claim 16, TRAN teaches a system for mapping technology using at least one computing device (fig. 1, a system for user(s) such as IP specialist or attorney in drafting or writing patent applications or patent claims as well as technical information as legal matters for a patent application: sections 0006, 0010 and 0132-0133), comprising:

at least one input device connected to the at least one computing device for inputting information from at least one user (inputting from one of client computers: fig. 1, items 104 and 106, sections 0035);

at least one processing means for automatically generating a diagrammatic representation of a technology (using graphical user interface and software for assisting the user in generating a patent application: sections 0042-0043 and fig. 2A and 2C), wherein the diagrammatic representation includes a hierarchical component categorization of the technical components of the technology based upon the information inputted by the at least one user, wherein the hierarchical component categorization includes at least one key component and at least one subcomponent related thereto (fig. 3B a claim tree, sections 0068; automatically generating a patent application: fig. 2's section 0042; technical component such as background, description, drawings and claims: abstract, figs. 2C, 3A and 4-5, sections 0008, 0016, 0044-0046

and 0101-0103; and independent claims and dependent claims: in fig. 3B claim tree and sections 0053-0054); and

at least one output device connected to the at least one computing device for outputting the automatically generated diagrammatic representation of a technology (the claim tree is displayed on the desktop screen, output device: section 0127 and fig. 3B).

Claim 17 is essentially the same as claim 16 except that it is directed to a method rather than a system, and is rejected for the same reason as applied to the claim 16 hereinabove.

With respect to claim 18, TRAN teaches a system for examining a patent application using at least one computing device (fig. 1, a system for user(s) such as IP specialist or attorney in drafting or writing patent applications or patent claims as well as technical information as legal matters for a patent application: sections 0006, 0010 and 0132-0133), comprising:

at least one input device connected to the at least one computing device for inputting information from at least one patent applicant (inputting from one of client (applicant or inventor or attorney) computers: fig. 1, items 104 and 106, sections 0035);

at least one processing means for automatically generating a diagrammatic representation of a technology (using graphical user interface and software for assisting the user in generating a patent application: sections 0042-0043 and fig. 2A and 2C), wherein the diagrammatic representation includes a hierarchical component categorization of the technical components of the technology based upon the information inputted by the at least one patent applicant, wherein the hierarchical

component categorization includes at least one key component and at least one subcomponent related thereto (fig. 3B a claim tree, sections 0068; fig. 3B a claim tree, sections 0068; automatically generating a patent application: fig. 2's section 0042; technical component such as background, description, drawings and claims: abstract, figs. 2C, 3A and 4-5, sections 0008, 0016, 0044-0046 and 0101-0103; and independent claims and dependent claims: in fig. 3B claim tree and sections 0053-0054); and

at least one output device connected to the at least one computing device for outputting a viewable diagram of the hierarchical component categorization for patent examiner to review the diagram as part of the examination of a patent application (the claim tree is displayed on the desktop screen, output device: section 0127 and fig. 3B and sections 0017).

Claim 19 is essentially the same as claim 18 except that it is directed to a method rather than a system, and is rejected for the same reason as applied to the claim 18 hereinabove.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pub. No.: US 2006/0190807 A1 of TRAN in view of Pub. No. US 2002/0161733 A1 of Grainger.

With respect to claims 7-10, TRAN teaches a system for drafting a patent application as discussed in claim 1.

TRAN teaches a system for user(s) such as IP specialist or attorney in drafting or writing patent applications or patent claims as well as technical information as legal matters for a patent application, generating an patent application including some technical components such background, invention summary, drawings, description, abstract and claims and displaying the claim tree to user. TRAN does not clearly teach wherein the link(s) are hyperlinks, wherein the document and diagram are capable of being output into another software program, wherein the document and diagram are exportable in HTML format and wherein the document and diagram are exportable in XML format.

However, Grainger teaches HTML link (sections 0038 and 0052), web browser (sections 0137 and 0159), HTML document (sections 0042 and 0052) and XML document (section 0038).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of TRAN with the teachings of Grainger. One having ordinary skill in the art would have found it motivated to utilize the use of facilitating the preparation of intellectual property (IP) documents, generating a document for filing as a patent application including patent's assessment, in the same conventional manner as described by Grainger (sections 0004 and 0023). thereby, securing and managing IP rights and assets (Grainger's section 0002).

Contact Information

8 Any inquiry concerning this communication or earlier communications from the examiner should directed to ANH LY, whose telephone number is (571) 272-4039 or via e-mail: ANH.LY@USPTO.GOV (**written authorization being given by Applicant(s) - MPEP 502.03 [R-2]**) or fax to (571) 273-4039 (examiner's personal fax number).

The examiner can normally be reached on TUESDAY – THURSDAY from 8:30 AM – 3:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **John Breene,** can be reached on **(571) 272-4107.**

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Any response to this action should be mailed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231, or faxed to:

Central Fax Center: (571) 273-8300

ANH LY
MAR. 6th, 2007

JOHN BREENE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100